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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,203	04/07/2004	Yutaka Konomura	P/2850-94	7409
2352 7590 08/07/2009 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
LEUBECKER, JOHN P				
ART UNIT		PAPER NUMBER		
3739				
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08/07/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,203

Applicant(s)

KONOMURA ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4-12 and 23-31 is/are pending in the application.
4a) Of the above claim(s) 8-12 and 28 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2-4-7, 23-27 and 29-31 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 7/16/09
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 23-27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakiyama et al. (U.S. Pat. 6,063,023) for the reasons set forth in numbered paragraph 3 of the previous Office Action, paper number 20090213.

As to claim 30, this claim is substantially similar except for the method step now recited in the last three lines of the claim. A method step in an apparatus claim is only given patentable weight to the extent of the structure or capability in which it suggests. As "wherein reading of the optical characteristic information from the optical adaptor to the reading section is performed upon attachment of the optical adapter to the tip of the endoscope insertion section" suggests no new structure, it does suggest a capability in which the Sakiyama et al. device is quite capable. Since there is no requirement in the Sakiyama et al. system as to the timing of attachment of the adapter (4) and insertion of information device (33), reading of the optical characteristic information from the information device can occur "upon attachment" of the optical adapter. In fact, Sakiyama et al. explicitly suggests that such reading step occurs at the time of attachment of the optical adapter (note col.6, lines 23-28).

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakiyama et al. (U.S. Pat. 6,063,023) in view of Heinrichs et al. (U.S. Pat. 6,092,722) for the reasons set forth in numbered paragraph 5 of the previous Office Action, paper number 20090213.

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakiyama et al. (U.S. Pat. 6,063,023) in view of Whitman et al. (U.S. Pat. 6,981,941).

Sakiyama et al. disclose an endoscope device comprising a control unit (2), an endoscope insertion section (2) having a tip (4) and a light receiving section (27,28) at the tip; an optical adaptor (4) which is detachably installed at the tip of the endoscope insertion section (Fig.4), the optical adaptor having an a stereo optical system (21,22, Fig.4) which forms an image in the light receiving section and an information device (FD 33) containing an optical characteristic information (col.6, lines 7-14), the optical characteristic information comprising focal lengths of the stereo optical system, a distance between optical axes of the stereo optical system and at least one distortion correction parameter for correcting distortion of an image of an object captured by the stereo optical system (col.6, lines 15-22); and a reading section (FDD 42) which reads the optical characteristic information from the optical adaptor (col.7, lines 30-33), wherein the control unit receives the optical characteristic information from the optical adaptor, corrects a distorted image using the at least one distortion correction parameter, and determines a geometric characteristic of the object using the focal lengths and the distance between the optical axes based on the corrected image (col.6, lines 23-53).

Since optical characteristic information is read from disk (33), Sakiyama et al. fails to disclose that the reading section comprises a joining terminal physically contacting the optical adaptor and that reading is performed via the physical contact between the optical adaptor and the joining terminal of the reading section.

Whitman et al. disclose a surgical device (20) including a plurality of adaptors (surgical instruments or attachments, col.5, lines 1-11) detachably securable to the distal end of the surgical device, wherein each adaptor includes a information device (memory unit 174, col.11, lines 27-40) for supplying information to a control unit (122, col.12, lines 11-22). The reading of the information device is performed when the adaptor is initially connected to the distal end of the surgical device through a connector (272, Fig.10) having contacts (276) (col.11, lines 27-28, col.12, lines 1-5). In view of this teaching, it would have been obvious to one of ordinary skill in the art to have connected the information device to the adaptor of Sakiyama et al. and read the information through contacts upon attachment of the adapter to the insertion section. Such improved modification would eliminate the need for an information device that is separable from the optical adaptor, thus preventing a lost disk (33) from hampering operation of the adaptor.

Response to Arguments

6. Applicant's arguments filed May 19, 2009 have been fully considered but they are not persuasive.

Applicant argues that claim 23 requires that the information device is disposed within the optical adaptor and that Sakiyama et al. does not disclose such. The Examiner respectfully

disagrees since claim 23 does not require that the information device is disposed within the optical adaptor. Therefore, this argument is rendered moot.

Applicant also confusingly argues that, assuming the alleged requirement of claim 23 as mentioned above, Heinrichs et al. fails to remedy the deficiency of Sakiyama. However, the Examiner must also respectfully disagree with this statement as it contradicts the very basis of the obviousness rejection previously set forth over Sakiyama et al. in view of Heinrichs et al. No explanation is given for Applicants conclusion, nor are any arguments presented with respect to the merits of the rejection.

New claims 30 and 31 are addressed above with respect to the prior art of record.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Leubecker/
Primary Examiner
Art Unit 3739

jpl